

Application No. 10/726,088

**REMARKS/ARGUMENTS**

Claims 1-4 are pending. Claim 5 is cancelled without prejudice.

Claims 1-4 stand rejected under 35 U.S.C. 103(a) as unpatentable over US Patent

No. 4,531,921 (von Torklus et al).

All rejections are thus respectfully traversed.

With regard to the foregoing rejections, the Examiner has conceded that the cited reference fails to disclose substantially the entire strap and strap closure member structures set forth in the claims. For example, on pages 5 and 6 of the Office Action the Examiner has conceded that the following structure is not disclosed by the cited reference:

Von Torklus et al. fail to disclose the first strap has a hook surface and an adjacent loop surface and being secured adjacent the exterior surface of the sleeve at a first attachment point and the second strap having a hook surface and an adjacent loop surface and being secured adjacent the exterior surface of the sleeve at a second attachment point located generally adjacent to the first attachment point so that the first and second straps may be positioned to extend in generally opposite directions around the exterior circumference of the sleeve, a first strap closure member secured adjacent the exterior surface of the sleeve and positioned between the first attachment point and the first end of the tubular member; and a second strap closure member secured adjacent the exterior surface of the sleeve and positioned between the second attachment point and the second end of the tubular member, wherein the device is positionable on the knee so that the tubular member is generally oriented across a front portion of the knee adjacent the patellar tendon by (1) exerting a first force on the first strap and passing the first strap through the first strap closure member and folding the first strap back to secure the hook material and the loop material of the first strap together to maintain application of the first force and (2) exerting a second force on the second strap and passing the second strap through the second strap closure member and folding the second strap back to secure the hook material and the loop material on the second strap together to maintain application of the second force. . .

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Despite this recognition of the structural differences, the Examiner (page 6 of the Office Action) has rejected the claims, alleging that the claimed structure represents "an obvious design choice" (emphasis added):

While the strap configuration and the manner in which the first and second straps are secured about the sleeve of the present invention are different from those disclosed in von Torklus et al., the equivalent first and second type forces are still applied to the tubular member, thereby achieving the same result. As such, the examiner contends that the claimed strap configuration is an obvious design choice.

However, rejections based on 35 U.S.C. Section 103(a) must rest on a factual basis. See, Ex Parte Boris E. Makutonin, Frank G. Oliverio, and Matthew J. Zdinak, 2003 WL 23014547 (Bd. Pat.App & Interf. Jan. 21, 2003), citing, In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). Accordingly, in making such a rejection, the Examiner has the initial duty of supplying the requisite factual basis and may not resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies on the factual basis. Id. See, also, Ex Parte Mark A. Krull, 2002 WL 31003013 (Bd. Pat. App. & Interf. 2002). In this rejection, the Examiner has based the rejection solely on impermissible hindsight derived from appellant's own disclosure.

In addition, the claimed structure advantageously enables the straps to be individually tensioned in a manner not possible with the structure of the cited reference. Accordingly, the rejection based on the Examiner's finding of "obvious design choice" is not sustainable. See, In re Gal, 980 F.2d 717, 25 USPQ2d 1076 (Fed. Cir. 1992).

Accordingly, withdrawal of the rejection and allowance of claims 1-4 is respectfully requested.

Applicant does not intend to surrender any range of equivalents under the Doctrine of Equivalents in regard to any claim limitation that appears in the final claims in any patent that may issue from this or any related application. Applicant expressly reserves the right to resort to the Doctrine of Equivalents for all limitations in regard to any future assertion of infringement of any claim, whether the limitation was present in an original claim or added by amendment a claim to or referenced in any argument to distinguish any claim from any prior art. All claims in any patent issued from this or any related application represent a statutorily presumed valid

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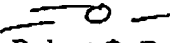
and patentable combination of structure and/or steps, and it is this combination which is presumed to patentably distinguish from the prior art, not any particular limitation of any claim.

Reconsideration and issuance of a Notice of Allowance is requested. In the event this response is not timely filed, Applicants hereby petition for the appropriate extension of time and request that the fee for the extension along with any other fees which may be due with respect to this paper be charged to our **Deposit Account No. 12-2355**.

Respectfully submitted,

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